

Appl. No. 10/032,867  
Amdt. dated January 06, 2005  
Reply to Office Action of September 28, 2004

PATENT

**REMARKS/ARGUMENTS**

Claims 1-14, 18, 20-22 and 49-52 were pending in the present application. Claims 6-10 have been withdrawn from consideration. Claims 1, 5, 11-14, 18, 20-22 and 49-51 have been rejected. Claims 2-4 and 52 were merely objected to as being dependent upon a rejected base claim but were indicated to be allowable if rewritten to include the limitations of the base claim and any intervening claims. Applicants gratefully acknowledge the indicated allowability of claims 2-4 and 52. The claims have been amended, canceled and new claims added as noted below. Reexamination and reconsideration of the claims as amended, are respectfully requested.

Applicants wish to thank the Examiner for the courteous interviews on December 20, 21 and December 28 of 2004. At the interviews on December 20 and 21, the Examiner and Applicants' representative discussed proposed amendments to put the application in condition for allowance in light of the Examiner's indication of the allowability of claims 2-4 and 52 in the present Office Action. The Examiner indicated there were additional references that he wished to consider. At the interview on December 28, the Examiner indicated the additional references were U.S. Patent Nos. 6, 086,586 to Hooven and 6,300,384 to Nezhat. Hooven was previously cited in an IDS submitted October 28, 2003. Applicants now cite Nezhat in supplemental IDS submitted with this response. The Examiner also discussed Yates '366 which was previously discussed by Applicants' representative in a personal interview with the Examiner on January 21, 2004. Then, as now, Applicants' representatives indicated that Yates '366 fails to describe a structure where a temperature sensitive material, typically a PTC material, is located between a conductive surface attached to an Rf generator and an electrode which will directly contact tissue. The Examiner and Applicants' representative again discussed proposed amendments to put the application in condition for allowance in light of the Examiner's indication of allowability of claims 2-4 and 52 in the present Office Action.

Appl. No. 10/032,867  
Amdt. dated January 06, 2005  
Reply to Office Action of September 28, 2004

PATENT

By the present amendment, Applicants have placed the application in condition for allowance on the basis of the allowability of dependent claims 2-4 and 52 indicated on page 8 of the current office action. That is the amendments have addressed all outstanding rejections and objections from the 9/28/04 office action including all rejections under 35 U.S.C. §103(a). Specifically, the application has been amended as follows:

- First, in order to expedite prosecution of the application, claims 2, 4, 6-10, 15-48 have been cancelled without prejudice to revival. Applicants reserve the right to prosecute these claims in continuation or divisional applications.
- Language that substantially recites the limitations of allowable dependent Claim 2 has been amended into independent Claim 1, thereby placing Claims 1, 5 and 11-14 in condition for allowance. In regard to the recitation of disposed in claim 1, Applicants state that disposed means "placed."
- Allowable dependant claim 52 has been amended to be put into independent format. Also, new dependant claims 53 to 56, which correspond in dependent subject matter to dependent claims 11-14, further define or further limit the subject matter of independent claim 52. Thus, claims 52-56 are in condition for allowance.
- New independent claim 57 substantially contains the subject matter of previously amended independent Claim 1 in combination with language that substantially recites the limitation of allowable dependent Claim 3. Also, new dependent claims 58 to 63, which correspond in dependent subject matter to dependent claims 2, 5, 11-14, further define or further limit the subject matter of independent claim 52. Thus, claims 58 to 63 are in condition for allowance.
- New independent claim 64 substantially contains the subject matter of currently amended independent Claim 1 with the additional limitation of "an electrode adapted for contacting tissue" Also, new dependent claims 65 to 70, which correspond in dependent subject matter to dependent claims 3, 5, 11-14, further define or further limit the subject matter of independent claim 64. Thus, claims 64 to 70 are in condition for allowance.
- Finally, in order to obtain a varying scope of coverage on applicants' invention, independent method claim 71 is newly presented. This claim is fully supported in the

Appl. No. 10/032,867  
Amdt. dated January 06, 2005  
Reply to Office Action of September 28, 2004

PATENT

specification and claims as filled; no new matter has been added (See the specification e.g., at page 2, lines 1-4; page 3, lines 20-25 and page 19, lines 11-12). As is discussed below, this claim is considered immediately allowable.

### Rejections Under 35 USC § 103

Claims 1, 5, 12 and 18 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Goble '224 in view of Kirwan '550. This rejection is traversed in part and overcome in part. The rejection of claims 1, 5 and 12 has been overcome by the amendment of claim 1 as discussed above. The rejections of claim 18 and the rejections of its dependent claims 20-22 have been mooted in light of the cancellation of claim 18 and claims 20-22.

Claims 11, 13, 14 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goble et al. (USPN 5,451,224) in view of Kirwan, Jr.(USPN 6,298,550 B1) as applied to claims 1 and 18 above; and further in view of Yates (USPN 5,716,366) and still further view of Wallsten (USPN 5,571,153). The rejection of claims 11, 13, 14 has been overcome by the amendment of claim 1 as discussed above. The rejections of claims 20-22 have been mooted in light of the cancellation of claims 20-22.

Claims 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goble et al. (USPN 5,451,224) in view of Yates (USPN 5,716,366) and in further view of Wallsten (USPN 5,571,153). These rejections have been overcome by the amendment of claim 49. First, amended claim 49 now recites a "variably resistive material having a resistance that positively varies in response to a change in temperature." No where does Goble teach such a material. Instead, Goble teaches away from the concept, because Goble necessarily relies on the "NTC characteristics" of its electrode for "producing the required electrosurgical action." (Goble, Col 2 line 65 to Col 3, line 5; See also Goble, Col. 6, line 52 to Col 7, line 3). Moreover, modifying Goble to use the material of claim 49 would destroy a principle of operation of Goble that the portion of its electrode "in contact with the tissue cools down" (Goble, Col 2, lines 63-65; Col 6, lines 21-68 to Col 7, line 3; See also Col 9, lines 1-5). Thus, the skilled artisan would not be motivated to combine the PTC material of Yates '366 or Wallsten with Goble, because

Appl. No. 10/032,867  
Amdt. dated January 06, 2005  
Reply to Office Action of September 28, 2004

PATENT

such a material 1) teaches away from Goble, 2) destroys a principle of its operation and 3) would yield no expectation of success. Accordingly, withdrawal of the rejection is now respectfully requested.

Claim 49 has also been amended to now recite the limitation of "delivering Rf energy to said body portions to cause ohmic heating of the tissue, wherein energy application to said tissue is modulated by changes in resistance of said first body portion to prevent substantial dehydration of tissue proximate to the engagement surface." None of the cited references alone or in combination teach such a limitation. In fact, Goble necessarily teaches away in that Goble teaches the delivery of energy to cut tissue by arcing and cell destruction which necessarily results in tissue dehydration (See Goble Col 1, lines 19-21 and Col 7, lines 65-70). Further, not only does Goble teach the dehydration of tissue by arcing, but actually teaches the design of an electrode for "increasing the ability to produce arcing in the tissue" from its electrode. (Goble Col 7, lines 65-70). Accordingly, withdrawal of the rejection is now respectfully requested on this separate and additional basis.

Also in order to obtain a varying scope of coverage on applicants' invention, independent method claim 71 is newly presented. This claim is fully supported in the specification and claims as filled; no new matter has been added (See the specification e.g., at page 2, lines 1-4; page 3, lines 20-25 and page 19, lines 11-12). Claim 71 recites the limitation of "delivering Rf energy to said body portions to cause ohmic heating of the tissue, wherein energy application to said tissue is modulated by changes in resistance of said first body portion to prevent substantial desiccation of tissue proximate to the engagement surface." For reasons stated above in regard to claim 49, none of the cited references alone or in combination teach such a limitation. Accordingly, claim 71 is considered immediately allowable.

CONCLUSION


In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appl. No. 10/032,867  
Amdt. dated January 06, 2005  
Reply to Office Action of September 28, 2004

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

  
Joel M. Harris  
Reg. No. 44,743

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 650-326-2400  
Fax: 415-576-0300  
Attachments  
JMH:snb  
60376044 v1